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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,126	08/05/2002	Brett Smith	1367-9	2505
81099	7590	01/21/2009		
Thomas M. Galgano 20 W. Park Avenue Suite 204 Long Beach, NY 11561			EXAMINER SORKOWITZ, DANIEL M	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 01/21/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/089,126

Applicant(s)

SMITH ET AL.

Examiner

DANIEL M. SORKOWITZ

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 and 23-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 23-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Claims

This communication is in response to the RCE for application 10/089126 filed on 12/29/2008. Claim 22 has been cancelled by Applicant. Claims 1-21 and 23-30 have been examined.

Continued Examination Under 37 CFR 1.114

- (1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/23/2008 has been entered. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- (2) **Claim 1 and 17 rejected under 35 U.S.C. 102(b) as anticipated by US Patent Number 5,794,210 to Goldhaber et al. (hereinafter “Goldhaber”)**

Regarding claim 1, Goldhaber clearly discloses a system and method comprising; a consumer station which receives electronic data or images (figure 4, 104, column 11, lines 11-24); an information provider which delivers said electronic data or images to said consumer station (figure 1, 106, column 9 lines 62-67), a host with which said consumer station communicates and interacts (figure 1, 106, column 9 lines 62-67), an advertising provider in communication with said host and which delivers advertising to the host for selective viewing by the participant (figure 1, 106, column 9 lines 62-67); wherein advertisements are delivered randomly from the advertising provider via said host to said consumer station wherein, said participant, responsive to an invitation from said host can selectively view said advertising; wherein, when said consumer elects to view advertising from said advertising provider via said host the consumer receives rewards, credits or benefits commensurate with the length of time advertising is viewed (figure 3 60, column 10 lines 39-58) and wherein, the participant at the consumer station views said advertising material without requiring software downloaded and installed into the participant station from the host (column 11 lines 11-24).

Concerning the step of "when said consumer elects to view advertising from said advertising provider via said host the consumer receives rewards, credits or benefits commensurate with the length of time advertising is viewed and wherein, the participant at the consumer station views said advertising material without requiring software downloaded and installed into the participant station from the host "; that limitation is optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Regarding claim 17, Goldhaber clearly discloses a participant computer which receives electronic data or images, (figure 4, 104, column 11, lines 11-24) an information provider for providing said electronic data or images (figure 1, 106, column 9 lines 62-67); an advertising provider in communication with said participant computer (figure 1, 106, column 9 lines 62-67); Concerning the step of "the advertising provider communicates with said participant computer upon election by said participant responsive to an invitation from said advertising provider; wherein, the participant receives said advertising material by responding to a random invitation from the advertising provider appearing at the

participant's computer without requiring consumer oriented enabling software downloaded to the consumer computer, and wherein, when said participant elects to view advertising from said advertising provider the participant receives rewards, credits, bonuses or selected benefits commensurate with the length of time advertising is viewed" and the step of "when said participant elects to view advertising from said advertising provider the participant receives rewards, credits, bonuses or selected benefits commensurate with the length of time advertising is viewed"; these limitations are optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- (3) Claims 2-16, 18-21, and 23-30 rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber in view of US Patent Number 6,928,615 to Haitzuka et al. (hereinafter "Haitzuka").**

Regarding claim 2, Goldhaber does not explicitly teach an invitation cancelling itself and reappearing randomly at a later time. Haitzuka clearly discloses a predetermined idleness criteria such that in the event the participant station fails to respond to the random invitation within a predetermined period, the invitation will cancel itself and reappear at a later time at the participant station allowing the participant repeated opportunity to elect whether to receive advertising material while on line.(figure 2, 110, column 12 lines 7-10). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Goldhaber and Haitzuka to have a predetermined idleness criteria such that in the event the participant station fails to respond to the random invitation within a predetermined period, the invitation will cancel itself and reappear at a later time at the participant station allowing the participant repeated opportunity to elect whether to receive advertising material while on line. Haitzuka teaches that this self canceling and reappearing process permits browsing by the user and displaying of advertisements by the client application without

interfering with the user's use of the browser application (column 12 lines 19-20).

Concerning the step of "in the event the participant station fails to respond to the random invitation within a predetermined period, the invitation will cancel itself and reappear at a later time at the participant station allowing the participant repeated opportunity to elect whether to receive advertising material while on line"; "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Regarding claim 3, Goldhaber clearly discloses the participant is able to view advertising simultaneously with information from said information provider at the option of the participant consumer, thereby allowing the participant to offset the cost of on line time commensurate with the extent of exposure to advertising provided by the advertising provider (column lines 50-57).

Regarding claims 4 and 20, Goldhaber clearly discloses an advertising station remote from the participant station (figure 1 110, column 9 lines 62-66)

Regarding claim 5, Haitsuka clearly discloses a flashing icon (column 10 lines 10-15).

Regarding claim 6, Goldhaber clearly discloses where participant station is a computer (figure 1 104, column 9 lines 35-38).

Regarding claim 7, Haitsuka clearly discloses wherein said participant station is a digital television receiver, web pad or Wireless Application Protocol phone (figure 1 100, column 5 lines 9-13).

Regarding claim 8, Haitsuka clearly discloses advertisements appear at a predetermined location on a display at the consumer station. (Figure 5 210, column 10. lines 1-3).

Regarding claim 9, Haitsuka clearly discloses advertising appears at said consumer station as a banner on said display (Figure 5 210, column 10. lines 11-15).

Regarding claim 10, Haitsuka clearly discloses said icon appears at any location within a banner (Figure 5 210, column 10. lines 11-15).

Regarding claim 11, Haitsuka clearly discloses a movable banner (Figure 5 210, column10. lines 11-15).

Regarding claim 12, Haitsuka clearly discloses an icon visible irrespective of its location within said banner and when received at said consumer station is enabled by an internet browser appearing in a banner (Figure5 210, column10. lines 11-15).

Regarding claim 13, Haitsuka clearly discloses advertising selected for viewing by said participant is displayed independent of any data or images displayed on said screen at said consumer station (column 12 lines 18-21).

Regarding claim 14, Haitsuka clearly discloses wherein viewer software enabling the consumer to view advertising, is browser driven such that said software is embedded into said viewer software and wherein said viewer software does not remain at the consumer station on the computer at the termination of viewing said advertisements (figure 1 160, column 5 lines 46-48, column 5 line 64 – column 6 line 8).

Regarding claim 15, Goldhaber clearly discloses a participant registering with said advertising provider by providing a consumer profile. (Figure 7 124 column 13 lines 28-30)

Regarding claim 16, Goldhaber clearly discloses rewards comprising rebates to participants for the costs of internet time commensurate with the time spent viewing advertising (figure 3 60, column 10 lines 54-57).

Regarding claim 18, Haitsuka clearly discloses said participant computer is connected to the internet and wherein said invitation is random and appears as a flashing icon on the screen of the consumer computer terminal, the process including a predetermined idleness criteria such that in the event the participant computer fails to respond to the random invitation within a predetermined period, the invitation will terminate and reappear randomly at a later time on the participant computer thereby allowing the participant repeated opportunity to elect whether to receive advertising material while on line (figure 2, 110, column 12 lines 7-10). Concerning the step of "in the event the participant computer fails to respond to the random invitation within a predetermined period, the invitation will terminate and reappear randomly at a later time on the participant computer thereby allowing the participant repeated opportunity to elect whether to receive advertising material while on line"; that

limitation is optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Regarding claim 19, Haitsuka clearly discloses the participant is able to view advertising simultaneously with Internet information at the option of the participant, thereby allowing the participant to offset the cost of Internet time commensurate with the extent of exposure to advertising provided by the advertising provider (figure 3 280 and 300, column 12 lines 17-20). Concerning the step of "the participant is able to view advertising simultaneously with Internet information at the option of the participant, thereby allowing the participant to offset the cost of Internet time commensurate with the extent of exposure to advertising provided by the advertising provider"; that limitation is optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Regarding claim 21, 23, 24, 27-30, Goldhaber clearly discloses an advertising provider in communication with said participant computer while the participant is obtaining data or information from an information

provider, wherein the advertising provider communicates with said participant computer via the advertising provider's web site (figure 1, 106, column 9 lines 62-67) upon election by said participant responsive to an invitation from said advertising provider; wherein, without requiring software downloaded to the participant computer, the participant views said advertising material by responding to a random invitation from the advertising provider appearing on the participant computer (column 10 lines 39-56) ;in the event the participant computer fails to respond to the invitation within a predetermined period the participant will not receive advertising nor credits, cash, prizes or like incentives for viewing said advertising, whereupon the invitation will reappear randomly at a later time on the participant's computer display allowing the participant repeated opportunity to elect whether to receive advertising material while on line (fig 3 60, column 10 lines 39-58), wherein upon acceptance by the consumer of advertising by signaling the advertising provider, advertisements will be sent to the consumer's computer for a predetermined random period following which the advertisements will be suspended until reactivated by the consumer by signaling the advertising provider; the process thereby allowing the participant to view advertising simultaneously with Internet information at the option of the participant, thereby allowing the participant to receive credits, prizes or like or to offset the cost of Internet time commensurate with the extent of exposure by the

participant to advertising messages; the process operable without the need for the consumer to download specific software, and registering with the advertising provider by forwarding to the provider the participant's identifying information (figure 7, 120, column 12 line 37-50). Goldhaber does not explicitly disclose said random invitation appearing as a flashing icon on a display the participant computer and including a predetermined idleness criteria. Haitsuka clearly discloses a predetermined idleness criteria such that in the event the participant station fails to respond to the random invitation within a predetermined period, the invitation will cancel itself and reappear at a later time at the participant station allowing the participant repeated opportunity to elect whether to receive advertising material while on line (figure 2, 110, column 12 lines 7-10). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Goldhaber and Haitsuka to have a predetermined idleness criteria such that in the event the participant station fails to respond to the random invitation within a predetermined period, the invitation will cancel itself and reappear at a later time at the participant station allowing the participant repeated opportunity to elect whether to receive advertising material while on line. Haitsuka teaches that this self canceling and reappearing process permits browsing by the user and displaying of advertisements by the client application without interfering with the user's use of the browser application (column12 lines

19-20). Concerning the steps of "upon election by said participant", and "in the event that...", and "allowing the participant repeated opportunity to elect whether to receive advertising material while on line", and "allowing the participant to view advertising simultaneously with Internet information at the option of the participant"; these limitations are optional, and according to the MPEP, "language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation" (MPEP 2106.II. C).

Regarding claim 25, Haituka clearly discloses displaying advertising targeted in a banner to a participant profile until such time as the participant cancels the advertising.(figure 3, 230, column 11 lines 51-55)

Regarding claim 26, Goldhaber clearly discloses sending particulars of the participant computer such as the computer's Email address to the advertising provider to establish a participant profile link between the participant computer and the advertising provider computer (column 12 lines 38-67).

Claims 1, 17, 24, and 30 have been amended to change the word for a user from "person" or consumer to "participant". Examiner considers these to be equivalent terms with respect to the application of prior art.

Claims 17 and 18 have been amended to change the word for a user's computer from "participant computer" to "participant station". Examiner considers these to be equivalent terms with respect to the application of prior art.

Claims 21, 24, and 26 have been amended to change the word for a user's computer from "participant computer" to "participant display". Examiner considers these to be equivalent terms with respect to the application of prior art.

Claims 21, 28 have been amended to change the word from "Internet" to "online". Examiner considers these to be equivalent terms with respect to the application of prior art.

Therefore, the Examiner maintains the rejection to the Applicant's claims.

Conclusion

All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of

record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Daniel Sorkowitz whose telephone number is (571) 270-5206.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/D.M.S./
Examiner, Art Unit 3622

/M. B./
Examiner, Art Unit 3622

/Eric W. Stamber/
Supervisory Patent Examiner, Art Unit 3622